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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,926	09/02/1999	HIEN D. MA	38910	4658

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/11/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,926

Applicant(s)

MA ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Status of Claims

1. Claims 1-20 have been examined.

Response to Amendments/Arguments

2. The Applicant's amendment and associated arguments filed 11/26/02 have been fully considered but are found not be persuasive. The Applicant is of the opinion that the prior art combination used to reject claims 1-20 is no longer applicable, as claims 1, 10 and 13 have been amended to read digital signals that comprise a digital audio broadcast segment. The Examiner respectfully disagrees. Both Payton and Stepp et al. teach signals encoded using MPEG compression algorithms ('440, column 4, lines 55-62; '935, column 4, lines 59-64), a technique that is used to process both video and audio signals. Therefore, to one of ordinary skill, this clearly suggests that the Stepp et al. system can be applied to digital audio broadcasts. The Applicant's argument is based on properties of radio broadcasting (paper 19, page 3, lines 7-20). However, the claims broadly recite "digital audio", which apply not only to radio but also to other digital signals that comprise sound, such as those signals that are processed by TV and computer ('935, column 6, lines 20-25). The Applicant attempts to exclude the Stepp et al. system by stating that video broadcasts are

scheduled on the hour or half-hour. The Examiner agrees with the Applicant that Stepp et al. teach inserting start time data into a signal, however, the rejection is still valid as the Applicant has not put forth a claimed limitation excluded such a property. Further, music videos are signals that can be disseminated by the digital information delivery system ('935, figure 2), and that occur at irregular intervals depending on the length of the preceding broadcasts segments, how long the DJ (or VJ) speaks between songs, news interruptions, advertisements...etc.. Thus a user can view music video signals and selectively record, or not, using the buffer of Stepp et al..

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton, U.S. Patent No. 5,790,935 in view of Iwamura, U.S. Patent No. 6,272,535, Park, U.S. Patent No. 5,757,909 and Stepp et al., U.S. Patent No. 6,363,440.

As per claims 1-20, Payton teaches a virtual on-demand digital information delivery system comprising:

- a receiver that receives an encrypted digital signal (audio, video or other) (column 1, lines 15-27; column 4, lines 55-67; column 5, lines 55-67)
- memory for storing an encrypted digital signal (column/line 2/64-3/9; column 6, lines 1-19)
- a recorder for recording onto a recording medium (column 6, lines 20-50; column 8, lines 11-25)
- a recording medium player (figure 5; column 6, lines 20-50; column 8, lines 11-25)
- plurality of recording mediums that record deciphered digital signals (column 6, lines 20-50)
- combined player and recorder (column 6, lines 20-50)
- decryption of encrypted signal (column 6, lines 1-20)
- storing encrypted digital signals in a memory device as it is being received (column 4, lines 55-67; column 6, lines 1-20 and 44-50)

Payton does not explicitly recite a buffer connected to a receiver or determining whether the beginning of a signal is in the buffer and recording the signal if the

beginning is present. Stepp et al. teach a signal recording method and apparatus comprising: a buffer connected to a receiver for storing at least a portion of the signal (figure 1; column 1, lines 42-59; column 4, lines 1-32), determining whether the beginning of a signal is present in said buffer and a user recording the signal to a recording medium if the beginning of the desired signal is present (figure 3; column 4, lines 32-56; column 5, lines 1-45). However, neither Payton nor Stepp et al. teach payment cards. Iwamura teaches a user terminal for receiving digital content, where the terminal is associated with an accounting apparatus (figure 8). Iwamura also teaches an accounting apparatus that deducts value from a card (e.g. smart, pre-paid, credit, debit... etc.) that stores monetary credits (column 5, lines 24-30; column 6, lines 10-30), determines whether a card has sufficient value and allows a user to add value to the card in order to access data (column column/line 5/24-6/37). While Park teaches encryption keys and utilizes smart cards to decrypt digital signals transmitted to a user terminal (column 1, lines 5-26 and 44-55; column 2, lines 31-37; column/line 3/62-4/17; column 4/55-5/5; column 6, lines 29-67; column/line 7/65-8/16; column/line 9/64-10/15; column/line 11/53-12/10; column 13, lines 22-29). Therefore, it would have been obvious to combine the teachings of Payton, Stepp et al., Iwamura, and Park. Payton teaches delivering digital information to users ('935, figure 2). By implementing the system of Payton with the teachings of Stepp et al., users can record, " ... a program in its entirety from the beginning even though the decision

to record the program occurs after the program occurs after the program starts and has been broadcast for a non-zero duration. ('440, column 1, lines 11-28)" Payton also teaches user payment for downloaded digital items ('935, column 4, lines 64-67), therefore, it would have been obvious to pay for access using the smart card of Iwamura as he teaches an accounting apparatus using a card to pay for access to digital data ('535, column 1, lines 5-17), such as content that the user decides to record to a medium from a buffer ('440, figure 3; column 4, lines 32-56; column 5, lines 1-45). Payton and Iwamura also teach that digital data should be encrypted to prevent illegal or unauthorized usage ('935, column 4, lines 60-67; '535, column/line 15/24-16/56). Hence, using smart cards to store encryption keys would lead to increased efficiency as it combines data security ('909, abstract) with a method for obtaining, or paying, for digital content.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

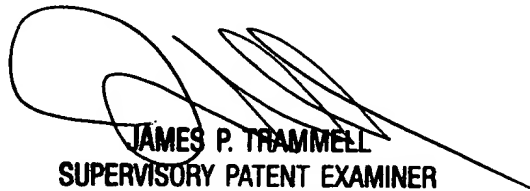
(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

December 9, 2002



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600